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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Robert Weisberger, Richard C.
Serial No.: 09/494,799 Art Unit: 3693
Filed: January 31, 2000 Conf. No.: 3973
For: SYSTEM FOR ACCESS TO AND EXCHANGE OF MARKET DATA

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
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Sir:

In response to the Final Office Action mailed August 5, 2010 and accompanying a Notice of Appeal to the Board of Appeals and Interferences in the United States Patent and Trademark Office appealing the final rejection of pending claims 31-44 in the above-referenced case, Applicant requests a pre-appeal brief review and request consideration of the following remarks, pursuant to the July 12, 2005, Official Gazette Notice entitled “New Pre-Appeal Brief Conference Pilot Program” and the February 7, 2006, Official Gazette Notice entitled “Extension of the Pilot Pre-Appeal Brief Conference Program.”

Applicant submits that (1) the rejection of claims 32-34, 36-41 as directed to non-statutory subject matter under 35 USC 101 and for being indefinite under 35 USC 112, second paragraph, should be withdrawn because claims 32-34 and 36-41 are properly limited to a single statutory class, (2) that the Examiner's rejection of claims 32-43 as failing to comply with the written description requirement pursuant to 35 USC 112 is improper since these claims are clearly described in the specification in a manner that apprises those of ordinary skill in the art of the Applicant's possession of the claimed invention, and (3) that the Examiner's restriction of claim 44 as not commensurate in scope with claim 31 is improper since those claims are identical, in every substantive aspect, with claim 31.

Claims 32-34, and 36-41 are directed to claims which are limited solely to the apparatus statutory class.

In *IPXL Holdings v. Amazon*, the court affirmed the rule that 35 USC 112, second paragraph, requires a single claim be limited to one statutory class. *IPXL Holdings v. Amazon.com, Inc.*, 430 F.3d 1377, 1384 (Fed Cir. 2005) Applicant does not challenge the legal precedence of *IPXL* nor the rule on which the decision rests. Instead, Applicant contends that the rule does not render the currently pending claims invalid because the currently pending claims are, in fact, limited to one statutory class.

The IPXL court found that claim 25 of IPXL's patent improperly recited both a system and a method of using that system. *Id.* In order to reach such a conclusion, the court analyzed the infringement ambiguity that a claim directed towards more than one statutory class raised. *Id.* The court indicated that a claim reciting both a system and a method for using that system makes infringement unclear. *Id.* Specifically, such a claim obscures whether infringement occurs through mere creation of such a system or through the use of such a system in a manner particularly prescribed by the claims. To demonstrate and emphasize the obscurity created, the court in *IPXL* cited *Ex parte Lyell*, 17 USPQ2d 1548 (B.P.A.I 1990), where the Board of Patent Appeals and Interferences, when confronted with determining whether a claim recited both an apparatus and method, also determined the claim scope by analyzing the extent of infringement ambiguity spawned by such claims. The court in *IPXL* noted that in *Lyell*, the board analyzed whether or not a manufacturer of an apparatus would be doubly liable for direct infringement in producing the product and for contributory infringement by virtue of a buyer or user of the manufactured apparatus performing a claimed method of using the apparatus. *Id.* The *IPXL* court noted that a claim distorting infringement and making its bound of infringement unclear is ambiguous and is properly rejected under section 112, paragraph 2. *Id.*

Claims 32-34 and 36-41 do not raise such ambiguities in infringement liability because they are directed to only a single statutory class, namely the apparatus class. These dependent claims do not recite methods of using an on-line interactive computer price discovery system. In contrast, these claims each simply provide functional requirements that restrict the nature of the data produced by the system of independent claim 31. An infringement analysis, akin to that made in *Lyell* and *IPXL* may be made here also. In the context of the pending claims, the analysis requires determining if any

of the dependent claims 32-34 and 36-41 prohibit specifically prescribed methods of using the on-line interactive computer price discovery system.

Claim 32, for example, requires a system within which a user may review, via a display screen, data from a query to the system. Stated differently, claim 32 requires a system that produces data reviewable by a user on a display screen. The effect of such a claim is merely to specify functional limitations of the system components. Per the analysis provided in *IPXL*, if claim 32 recited a prescribed method of using a system, it would render reviewing, on a display, data produced by a system of claim 1, an infringing activity.

It is clear that claim 32 does not provide a specific method of reviewing data on a display screen, which is infringed based on using the apparatus according to that specific method. Instead, claim 32 implicates systems capable of producing data reviewable on a display screen pursuant to a query to such a system. Claim 32 does not make the very act of reviewing data on a display actionable, but instead makes a system capable of producing such a display actionable without regard to whether or not a user actually engages in reviewing the data via a display or whether the user reviewed it in a particular manner. Similar to claim 32, each of claims 33-34 and 36-41 recite functional requirements that are infringed by a system and are limited to one statutory class.

Since each of claims 32-34 and 36-41 fail to render a users act of reviewing data on a display screen actionable for infringement, none of these claims is indefinite under 35 USC 112, second paragraph, and each of these claims is directed to statutory subject matter under 35 USC 101, namely an apparatus and an apparatus alone.

Each of claims 32-43 is supported in the originally filed specification and thus satisfies the written description requirement of 35 USC 112, first paragraph.

Support for each of claims 32 through 43 is shown by the following citations.

Claims 32 and 33, 41: Page 10, lines 9-20 demonstrates to one of ordinary skill in the art that the inventor possessed data from a search query being displayable on a screen for review;

Claim 34, 42, 43: Page 11, lines 5-6 and page 12, lines 18-20 clearly conveys to one of ordinary skill in the art that the inventor possessed the ability to collect data from a query in real-time and the ability to automatically update a search query;

Claim 35: Page 12, lines 18-20 shows that the inventor possessed automatically updating a search query;

Claim 36: Page 6, lines 1-9 illustrates querying the securities market data;

Claim 37: Page 6, lines 1-9 demonstrates querying;

Claim 38: Page 13, lines 7-23 demonstrates querying items recited in claim 38;

Claim 39 Page 13, lines 21-23 illustrating support for sorting data in an ascending or descending matter.

Since each of these claims is clearly supported in such a manner that would apprise one of ordinary skill in the art of the possession of the invention claimed by each of these claims, all of these claims satisfy the written description requirement.

Claim 31 and 44 are not distinct claims and thus the restriction of claim 44 from claims 31-43 is improper

Pursuant to the restriction requirement provided in the final office action of August 5, 2010 Applicant elects, as noted by the examiner claims 31-43. This election is made with traverse and Applicant herein requests reconsideration and withdrawal of the restriction requirement since claims 31 and 44 are commensurate in scope, namely because claim 44 simply provides a process of using the system of claim 31.

As noted in the MPEP section 806.5(h) showing that a product and a process of using the product are distinct requires a showing that either (A) the process of using as claimed can be practiced with another materially different product or (B) the product as claimed can be used in a materially different process.

No product that is materially different from the system provided by claim 1 can be used to practice the process of claim 44. Step A of claim 44 requires storing in a database securities data including a security identify field, a price field, a price source field and a price source date field. There is no storage product that is materially different from the database of element A of claim 31 that can be used to practice the process of claim 44. Claim 31 requires that the databases of elements A-D be programmed to store the same data that processes A-D of claim 44 requires be stored. Additionally there are no processors (or any other devices) that are materially different from the processors provided by elements E-G of claim 31, that can be used to receive, display and update the data required to be received, displayed and updated by elements E-G of claim 44. The

product of claim 31 is specifically adapted for achieving the steps required by method claim 44 and any product capable of achieving the steps of method claim 44, must be materially similar to the product of claim 31.

Furthermore, because the product of claim 31 is specifically adapted for achieving the steps required by method claim 44, the product of claim 31 cannot be used to practice a method that is materially different from the method required by claim 44.

Accordingly, no showing has been made, and indeed Applicant believes no showing can be made, which will demonstrate that the system of claim 31 is distinct from the method of claim 44, at least for the reason identified above.

Since 37 CFR 1.142 permits restrictions to be made only where claims are both independent and distinct, and no showing may be made demonstrating that the invention of claims 31 and 44 are distinct as indicated above, the restriction of claim 44 from claims 31-43 is improper. Thus, Applicant respectfully requests that this restriction be reconsidered and withdrawn and that claim 44 be rejoined to the pending claims.

CONCLUSION

In view of the above remarks, Applicants believe the pending application is in condition for allowance. Applicants believe no fee is due with this statement. However, if a fee is due, please charge our Deposit Account No. 03-1721.

Respectfully submitted,
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Dated October 5, 2010

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